

Appl. No. : 09/608,819
Filed : June 30, 2000

REMARKS

The foregoing amendments and the following remarks are responsive to the June 15, 2005 Final Office Action. Claims 1, 3, 4, 7-12, 14-18, 20, 21, 24, and 26 are amended, Claims 2, 6, 13, 22, and 23 remain as originally filed, Claims 5 and 19 are cancelled without prejudice, and Claims 25 and 27 remain as previously presented. Thus, Claims 1-4, 6-18, and 20-27 are presented for further consideration.

Response to Rejection of Claim 1 for Obviousness-Type Double Patenting

In the June 15, 2005 Final Office Action, the Examiner rejects Claim 1 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 9 of U.S. Patent No. 6,425,128 B1 issued to Krapf et al. ("the '128 patent").

As discussed herein, Applicant has amended Claim 1. Applicant respectfully traverses this rejection on the basis that amended Claim 1 of the present application is not obvious in view of either Claim 1 or Claim 9 of the '128 patent. However, in order to expedite allowance of the present application, Applicant would consider submitting a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) if the Examiner finds that amended Claim 1 is otherwise allowable.

Applicant respectfully requests that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

Response to Rejection of Claims 1-27 Under 35 U.S.C. § 103(a)

In the June 15, 2005 Final Office Action, the Examiner rejects Claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 B1 issued to Alexander et al. ("Alexander") in view of U.S. Patent No. 6,029,045 A issued to Picco et al. ("Picco").

Claim 1

Applicant has amended Claim 1 to recite (emphasis added):

1. A video system, comprising:
 - an input port configured to receive video data from a head end, the video data including a plurality of premium contents;
 - an output port configured to couple to a video display for displaying video data selected by a viewer;
 - a preference engine coupled to the input port and configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of the viewer;
 - a personal video recorder configured to locally store premium content** from the plurality of premium contents;
 - a local storage device; and

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a promotion module coupled to the preference engine and the output port, the promotion module responsive to the viewer profile to select at least one preferred promotion content from the plurality of premium contents, to cause the selected at least one preferred promotion content to be stored on the local storage device, and to cause the selected at least one preferred promotion content to be retrieved from the local storage device and displayed **to entice the viewer to watch the locally stored premium content associated with the selected at least one preferred promotion content.**

The as-filed specification of the present application provides support for these amendments, including but not limited to, page 4, lines 12-14; page 5, lines 23-27; page 6, lines 9-12; and page 6, line 29 –page 7, line 13.

Applicant submits that amended Claim 1 includes limitations not disclosed or suggested by either Alexander or Picco. For example, neither Alexander nor Picco discloses or suggests a video system comprising a “promotion module responsive to the viewer profile to select at least one preferred promotion content ... to cause the selected at least one preferred promotion content to be ... displayed **to entice the viewer to watch the locally stored premium content** associated with the selected at least one preferred promotion content” (emphasis added), as recited by amended Claim 1.

Alexander discloses a system and method which receives and stores programs on videotape or DVD (see, e.g., Alexander at column 12, lines 10-51) and which receives and stores advertisements in RAM for current or future telecast programs (see, e.g., Alexander at column 4, lines 28-33; column 25, lines 28-34). The advertisements disclosed by Alexander originate from the head end, and they are associated with current or future telecast programs from the head end. Alexander does not disclose or suggest that the advertisements are for programs which have been locally stored on the system.

Picco discloses a system and method for providing targeted advertising content to users of a national transmission medium, such as satellite (see, e.g., Picco at column 2, lines 49-67). The advertisements disclosed by Picco originate from the head end, and they are associated with products and services of geographically local interest. While Picco discloses selectively storing and/or displaying the advertising content from the head end based on a user profile (see, e.g., Picco at column 6, lines 23-34), Picco does not disclose or suggest that the advertisements are for programs which have been locally stored on the system.

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Neither Alexander nor Picco discloses or suggests a “promotion module . . . to cause the selected at least one preferred promotion content to be . . . displayed **to entice the viewer to watch the locally stored premium content.**” (Emphasis added.) Because the cited prior art does not disclose or suggest all of the limitations of amended Claim 1, Applicant submits that amended Claim 1 is patentably distinguished over Alexander in view of Picco. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

Claims 2-11, 24, and 25

Applicant has cancelled Claim 5 without prejudice. Each of Claims 2, 3, 6, 10, 24, and 25 depends from amended Claim 1, each of Claims 4 and 7 depends from Claim 3, Claim 8 depends from Claim 7, Claim 9 depends from Claim 8, and Claim 11 depends from Claim 10. Therefore, each of Claims 2-4, 6-11, 24, and 25 includes all the limitations of amended Claim 1, as well as other limitations of particular utility. For at least the reasons discussed above in relation to amended Claim 1, Applicant submits that each of Claims 2-4, 6-11, 24, and 25 are patentably distinguished over Alexander in view of Picco. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 2-4, 6-11, 24, and 25 and pass these claims to allowance.

Claim 12

Applicant has amended Claim 12 to recite (emphasis added):

12. A method of operating a video system that receives video data that includes a plurality of premium contents, the method comprising:
creating a viewer profile representing viewing preferences of a viewer;
identifying premium content from the plurality of premium contents consistent with the viewer profile;
locally storing the identified premium content;
selecting a promotion content associated with the identified, locally stored premium content;
storing the selected promotion content on a local storage device; and
retrieving the selected promotion content from the local storage device and
displaying the selected promotion content to entice the viewer to watch the identified, locally stored premium content.

For similar reasons to those discussed above with regard to amended Claim 1, Applicant submits that amended Claim 12 includes limitations not disclosed or suggested by either Alexander or Picco. For example, neither Alexander nor Picco discloses or suggests a method of operating a video system which locally stores premium content by “identifying premium

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content,” “selecting a promotion content associated with the identified, locally stored premium content,” and “displaying the selected promotion content **to entice the viewer to watch the identified, locally stored premium content**” (emphasis added), as recited by amended Claim 12. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 12 and pass Claim 12 to allowance.

Claims 13-23, 26, and 27

Applicant has cancelled Claim 19 without prejudice. Each of Claims 13-15, 17, 23, 26, and 27 depends from amended Claim 12, Claim 16 depends from Claim 15, each of Claims 18 and 20 depends from Claim 17, and Claim 22 depends from Claim 21. Therefore, each of Claims 13-18, 20-23, 26, and 27 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. For at least the reasons discussed above in relation to amended Claim 1, Applicant submits that each of Claims 13-18, 20-23, 26, and 27 are patentably distinguished over Alexander in view of Picco. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 13-18, 20-23, 26, and 27 and pass these claims to allowance.

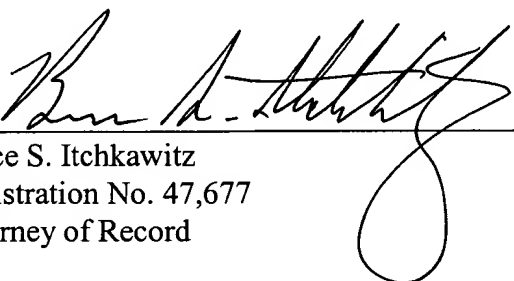
Summary

For the foregoing reasons, Applicant submits that Claims 1-4, 6-18, and 20-27 are in condition for allowance, and Applicant respectfully requests such action.

Respectfully submitted,

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